

adhesive is not necessarily an adhesive that is wet, but rather refers to the substrate that may be subjected to water or is actually immersed in water. Referring to the specification at page 5, lines 26-29, a “*wet stick adhesive*” refers to a material that exhibits pressure-sensitive adhesive properties when adhered to a substrate that has been flooded with water. *Wet-stick adhesives may or may not demonstrate pressure-sensitive adhesive properties under dry conditions.*” (Emphasis added).

***Rejection Under 35 U.S.C. 102(b)***

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,569,960 (Blake).

The Examiner has stated “Blake discloses a PSA and method of making it which fall within the scope of the instant claims.”

Applicants respectfully submit, “anticipation requires identity of invention. The claimed invention, as described in appropriately construed claims, must be the same as that of the reference in order to be anticipated.” *See Glaverbel Société Anonyme v. Northlake Marketing & Supply Inc.*, 45 F.3d 1550, 33 USPQ.2d 1496, 1498 (Fed. Cir. 1995).

The cited reference is directed to a *normally tacky and pressure-sensitive water-dispersible adhesive* especially suitable for splicing carbon-less paper, comprising the blended reaction product of: (a) a copolymer consisting essentially of (1) a (meth)acrylate and (2) an acid comonomer, (b) an ethoxylated plasticizing component, (c) and alkaline hydroxide. The compositions of the Blake reference and the present invention are different, not just functionally, but also compositionally different. Note that Blake requires the use of a hydroxide salt and the present invention does not.

The present invention claims an adhesive that is a tacky, hydrophilic pressure sensitive adhesive that retains its “stick” properties in water, whereas the reference is a water dispersible adhesive. In fact, the adhesives of the present invention may not even be sticky under dry conditions.

Water dispersibility means that the adhesive will disperse when exposed to water, which is appropriate if one seeks to recycle paper. Furthermore, the PSA composition in Blake is water-dispersed prior to coating and **must be dried** before the composition

behaves as a PSA. This PSA does not bond to an adherent in the presence of water, *in contrast to the present invention, which does bond to an adherent in the presence of water*. In summary, drying of the water-dispersion in Blake is essential to the formation of a PSA.

The adhesive of the present invention is comprised of the polymerization reaction product of (1) a (meth)acrylate, (2) a hydrophilic acid comonomer and (3) a non-reactive plasticizer. In the presence of water, the adhesive of the present invention remains intact and sticky, therefore is particularly useful for adhering to wet surfaces.

Applicants respectfully submit that the claims are not identical and therefore the cited reference fails to anticipate the claims of the present invention. In view of this failure to anticipate the claims, Applicants respectfully request the Examiner withdraw all 35 U.S.C. § 102(a) rejections.

***Rejection under 35 U.S.C. 103(a)***

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,569,960 (Blake).

The Examiner has stated "Blake discloses a PSA and method of making it which fall within the scope of the instant claims." The Examiner further states that it "would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed combinations of ingredients and amounts thereof in the PSA of the patentee because they are encompassed by the patentee and would have been expected to give a PSA having the properties of the PSA of the patentee."

Applicants respectfully submit that it would not have been obvious, as stated by the Examiner. The cited reference is directed to a water-dispersible adhesive for splicing paper rolls. The present invention is directed to an adhesive that is well suited for sticking onto a wet surface, such as a wet road, a wet wall, etc.

Applicants suggest that it would not have been obvious to modify the cited reference to make an adhesive that is well suited for wet surfaces by any of the teachings in the cited reference without hindsight knowledge of the present claims. Using the claims of the present invention as a road map is prohibited and fails to sustain an obviousness rejection.

Furthermore, the functionality of the adhesives of Blake and the present invention are sufficiently different that one of ordinary skill in the art would be unable to make an adhesive that bonds to an adherent in the presence of water (as in the present invention), without referring to the claims of the present invention.

Applicants respectfully request the Examiner withdraw the 35 U.S.C. § 103(a) rejection of the claims or provide specific evidence that the cited reference can be modified and that there is motivation within the cited reference to modify the cited reference without any referral to Applicants' claims.

Barring any specific evidence, Applicants respectfully submit that the claims of the present invention are patentable over the cited reference and that the 35 U.S.C. § 103(a) rejection cannot be sustained and should be withdrawn.

#### CONCLUSION

Applicants respectfully suggest this paper is fully responsive to the Office Action and the remarks and amendments have resolved the Examiner's outstanding objections and rejections. However, if after fully considering Applicants' response, there are issues remaining, Applicants request the Examiner telephone the undersigned to timely resolve any remaining issues.

Please charge any fees that may be associated with this paper to Deposit Account No. 13-3723.

Respectfully Submitted,

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